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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,030	08/31/2001	Richmond Muimo	002.00190	6001
7590 07/28/2004 Braman & Rogalskij, LLP PO Box 352 Canandaigua, NY 14424-0352			EXAMINER NOLAN, PATRICK J	
			ART UNIT 1644	PAPER NUMBER
DATE MAILED: 07/28/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,030

Applicant(s)

MUIMO ET AL.

Examiner

Patrick J. Nolan

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-12-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23,25,26,29-37,39-41,43-48 and 51-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23, 25,26, 29-37, 39-41, 43-48, 51-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 1644

DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-13 and 51 in the reply filed on 5-12-04 is acknowledged. However Applicant has traversed the species election.

The species election is withdrawn and a new restriction is set forth below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 6, 7, drawn to a method of detecting cystic fibrosis by detecting NDPK function or state, classified in class 435, subclass 29.
- II. Claims 4, 5, 7, 8 and 51, drawn to a method of detecting cystic fibrosis by detecting annexin histidine phosphorylation, classified in 435 subclass 4.
- III. Claims 7 and 9-11, drawn to a method of classifying a disease state associated with epithelial cell dysfunction by detecting phosphorylation of annexin and NDPK function and/or phosphorylation of other membrane proteins and/or ATPase activity, classified in class 435 subclass 4.
- II. Claims 14-22 and 52-53 drawn to a method of screening an agent, classified in class 435, subclass 4.
- V. Claims 23, 54-56, drawn to a compound, classified in class 514, subclass 1.
- VI. Claims 25-26, drawn to a method of treating, classified in class 424, subclass 184.1.
- VII. Claims 28-37, and 39, drawn to a peptide, classified in class 530, subclass 300.
- VIII. Claims 40-41, drawn to a method of treating with a peptide, classified in class 514, subclass 2.
- IX. Claims 43 and 45, drawn to a pentamer peptide comprising annexin residue 246, classified in class 514, subclass 17.
- X. Claims 44 and 57, drawn to a pentamer peptide comprising annexin residue 293, classified in class 514, subclass 17.

Art Unit: 1644

- XI. Claims 46-47, drawn to a method of making antibody by immunization with an immunogen, classified in class 424, subclass 184.1.
- XII. Claims 48-50 and 58, drawn to an antibody against any annexin peptide containing a phosphorylated histidine, classified in class 424, subclass 139.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions XI and XII are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the antibodies can be made by phage display libraries.

Inventions VII, IX and X and VIII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptides can be used to make antibodies.

Inventions I-III and IV-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the methods of screening and detecting and treating have different endpoints and method steps.

Inventions V and VI-X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case any of the peptide or generic compounds can be used in the method of treatment.

Inventions IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

Art Unit: 1644

inventions prior art against invention IX would not necessarily read upon the claimed invention in invention X as the peptides are from different regions.

Inventions I or II or III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions prior art against invention I would not necessarily read upon the claimed invention in invention II or III. Prior art disclosing measuring NDPK function or state as required in Group I would not read upon Group II, nor would it read Group III, as Group III requires both annexin phosphorylation measurement and NDPK function measurement.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Nolan whose telephone number is 571-272-0847. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Y. Chan can be reached at 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Patrick Nolan".

Patrick Nolan, Ph.D.

Primary Examiner, Art Unit 1644

July 26, 2004